

Remarks:

The above amendments and these remarks are responsive to the Office action dated July 29, 2005. Prior to entry of this response, claims 1-10, 12, and 14-33 were pending in the application. In the Office action, 1) the drawings are objected to under 37 CFR 1.83(a); 2) claims 19-27 are allowed; 3) claims 1-10, 12, 14-15, and 28-33 are rejected under 35 USC 103(a) as being unpatentable over Kurematsu (US 6,808,271) in view of Goldenberg et al. (US 4,773,731) and Ogawa (US 6,513,935); and 4) claims 16-18 are objected to as being dependent upon a rejected base claim. In view of the amendments above, and the remarks below, Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

Allowable Subject Matter

Applicant thanks the Examiner for allowing claims 19-27, and indicating that claims 16-18 are allowable if rewritten in independent form.

Formal Matters

Applicant respectfully traverses the objection to the drawings. 37 CFR 1.81(a) only requires a drawing if it would be "necessary for the understanding of the subject matter sought to be patented." Applicant submits that one skilled in the art understands "different sized bumps," "different shaped bumps," and "a random distribution of bumps," even if there were no drawings. Nonetheless, in order to advance prosecution without further delay, Applicant is hereby presenting new Figures 20-22, which schematically show that which the Examiner has stated is not shown in Figures 1-19. New Figures 20-22 do not add new matter, because everything that is illustrated in Figures 20-22 is described in the original disclosure. See, for example, page 17, line 22 to page 18, line 3 (emphasis added):

In alternative embodiments, bumps 1370 are two-dimensional hills that are **regularly** or **randomly** distributed across the output side of Fresnel lens 1310. In an embodiment, at least one bump 1370 (e.g., 1370A) has a **different size** and/or **shape** than another bump (e.g., 1370B).

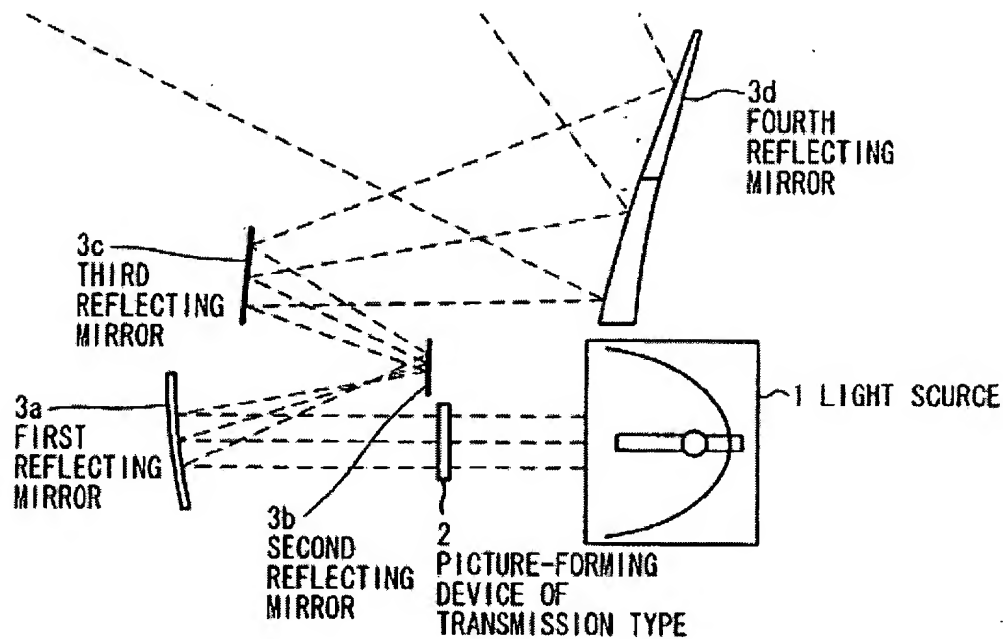
New paragraphs corresponding to Figures 20-22 have been added to the Brief Description of the Drawings. Again, no new matter has been added, as the new paragraphs mimic disclosure already present in the specification. Accordingly, objection to the drawings should be withdrawn.

Rejections under 35 USC § 103

All claimed elements are not found in the cited references

An Examiner must show that the cited prior art references teach or suggest all claim limitations in order to establish a prima facie case of obviousness. See MPEP 2143. According to Page 6 of the July 29, 2005 Office action, the 103 rejection of claims 1-10, 12, 14-15, and 28-33 relies on Ogawa for disclosing "an intermediate mirror (Figure 2, element 3a) substantially perpendicular to the optic axis (see Figure 2)."

Applicant respectfully points the Examiner's attention to independent claims 1, 15, and 28, which each recite "a **substantially planar** intermediate mirror." (emphasis added). As can be seen below, element 3a in Figure 2 is not substantially planar.



Ogawa only discloses mirrors that are either shaped into aspherical surfaces or freely curved surfaces. See for example, Col. 5, lines 48-55:

Furthermore, according to the first preferred embodiment, since the first and fourth reflecting mirrors 3a, 3d, are shaped into the aspherical surfaces and the second and third reflecting mirrors 3b, 3c are shaped into the freely curved surfaces, the reflecting mirrors can be shaped into ideally curved surfaces, and the satisfactory results which can never be achieved by an optical system composed of reflecting mirrors shaped into spherical surfaces can be obtained.

Because element 3a is not substantially planar, Ogawa cannot be relied on for showing “a substantially planar intermediate mirror.” This claim limitation is not shown in the prior art references, and therefore, prima facie obviousness has not been established. Accordingly, rejection of independent claims 1, 15, and 28, as well as all claims depending from those claims, should be withdrawn.

Furthermore, as discussed in the May 9, 2005 response, Goldenberg et al. does not disclose a plurality of bumps affixed to or formed on an output side of a Fresnel lens. Therefore, rejection of claim 1 and the claims depending from claim 1 should be withdrawn for at least this additional reason.

There is no motivation or suggestion to combine the cited references

Even if all claimed elements were present in the cited references, the combination of the cited references is improper because there is not a motivation or suggestion to combine the references. In order to establish a prima facie case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the referenced teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991), see also MPEP 2142. Moreover, the mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990), see also MPEP 2143.01. Furthermore, "The test for an implicit showing [of obviousness] is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (Emphasis added).

Applicant respectfully submits that no prima facie case of obviousness has been established because there is no suggestion or motivation to combine the above-cited references to obtain the presently claimed inventions. In particular, Ogawa does not include any indication whatsoever that it would be desirable to use its lens-less optical system with a Fresnel lens, Goldberg does not include any indication whatsoever that it would be desirable to use its disclosed lens assembly with a substantially planar intermediate mirror that is substantially perpendicular to the optic axis of a lens system, and Kurematsu does not include any indication that it would be desirable to affix bumps to or form bumps on its Fresnel lens. The Examiner has not pointed to any specific indication in any reference that suggests the claimed combination would be desirable. It is believed that Applicant's own disclosure is improperly being used as a template to combine what appear to be otherwise unrelated references. Therefore,

rejection of claims 1-10, 12, 14-15, and 28-33 should be withdrawn for at least this additional reason.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, Applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

**CERTIFICATE OF
TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postages as first class mail in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on September 12, 2005.


Nicole Fye

Respectfully submitted,
ALLEMAN HALL MCCOY RUSSELL & TUTTLE LLP



Jason C. Creasman
Registration No. 51,587
Customer No. 50488
Attorney/Agent for Applicant(s)/Assignee
806 S.W. Broadway, Suite 600
Portland, Oregon 97205
Telephone: (503) 459-4141
Facsimile: (503) 459-4142

Amendments to the Drawings:

Please add sheet 20/20 to the drawings. Sheet 20/20 incorporates the desired changes in the drawings. No new matter has been added.

Attachment: New Drawing Sheet 20/20